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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,613	08/13/2001	Galen M. Gareis	6500-1801.2	9701

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EXAMINER

MAYO III, WILLIAM H

ART UNIT	PAPER NUMBER
2831	

DATE MAILED: 04/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

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TECHNOLOGY CENTER 2800

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/929,613	GAREIS, GALEN M.
<b>Period for Reply</b>	Examiner	Art Unit
	William H. Mayo III	2831
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
<b>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</b>		
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
<b>Status</b>		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>22 February 2002</u> .		
2a) <input checked="" type="checkbox"/> This action is FINAL.                            2b) <input type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.		
<b>Disposition of Claims</b>		
4) <input checked="" type="checkbox"/> Claim(s) <u>1-6</u> is/are pending in the application.		
4a) Of the above claim(s) _____ is/are withdrawn from consideration.		
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.		
6) <input checked="" type="checkbox"/> Claim(s) <u>1-6</u> is/are rejected.		
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.		
8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.		
<b>Application Papers</b>		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner.		
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner.		
If approved, corrected drawings are required in reply to this Office action.		
12) <input checked="" type="checkbox"/> The oath or declaration is objected to by the Examiner.		
<b>Priority under 35 U.S.C. §§ 119 and 120</b>		
13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).		
a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of:		
1. <input type="checkbox"/> Certified copies of the priority documents have been received.		
2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.		
3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).		
* See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).		
a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.		
15) <input checked="" type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
<b>Attachment(s)</b>		
1) <input type="checkbox"/> Notice of References Cited (PTO-892)		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
6) <input type="checkbox"/> Other: _____		

## DETAILED ACTION

### *Oath/Declaration*

1. This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. Specifically, the major axis having a length larger than the length of the minor axis was not claimed in the parent case. A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda et al (JP Pat Num 4-332406, herein referred to as Ikeda). Ikeda discloses spacer type cable (Figs 1-4). Specifically, with respect to claim 1, Ikeda discloses a twisted pair cable separator spline (Fig 1) capable of being used with communication cable (Page 2, line 7) and comprising a longitudinally extending spline (5) having a plurality of spaced

longitudinally extending pockets (denoted as 30 & 40), a cross section of the spline (5) having a major axis (left to right, denoted as 20) and a minor axis (top to bottom, denoted as 10) and wherein at least one pocket (40) is on the major axis (20) and at least one pocket (30) is on minor axis (10). With respect to claim 2, Ikeda discloses that the major axis (20) is substantially perpendicular to the minor axis (10) and each of the pockets (30 & 40) longitudinally extends substantially parallel to each other (Fig 1). With respect to claim 4, Ikeda discloses that the spline (5) has a first (40), second (60), third (30), and fourth (50) spaced longitudinally extending open pocket (Figs 1), wherein a cross section of the spline (5) has a major axis (20) and a minor axis (10), and wherein the first and second pockets (40 & 60 respectively) have substantially the same cross sectional area (Figs 1) and the third and fourth pockets (30 & 50 respectively) have substantially the same cross sectional area (Fig 1). With respect to claim 5, Ikeda discloses that the major axis (20) is substantially perpendicular to the minor axis (10), the third and fourth pockets (30 & 50 respectively) have substantially the same cross sectional area (Fig 1) and the first (40), second (60), third (30), and fourth (50) spaced longitudinally extending open pockets are substantially parallel to each other (Fig 1). With respect to claim 6, Ikeda discloses that the first (40) and second (60) pockets have a depth that is equal to the depth of the third (30) and fourth (50) pockets.

However, Ikeda doesn't necessarily disclose the major axis having a length greater than a length of the minor axis (claim 1), nor the pockets having a cross sectional area which is 75% or less than the cross sectional of a circular envelope of a cable (claims 3 & 5), nor the first and second pockets having a depth greater than the

depth of the third and fourth pockets, wherein each of the pockets have a cross sectional area of about 25 to 75% the cross sectional area of the circular envelope of the twisted pair cable (claim 6).

With respect to claims 1 & 6, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cable separator spline of Ikeda to comprise the major axis to have a longer length than the minor axis wherein the first and second pockets will have a depth greater than the depth of the third and fourth pockets, since Ikeda teaches that the groove shape is not limited to the explained configuration and states that all types of variations in the design are included in the scope of the present invention and since it has been held that more than mere change of form or rearrangement of parts is necessary for patentability. *Span-Deck Inc v Fab-Con, Inc, (CA 8, 1982) 215 USPQ 835.*

With respect to claims 3 and 5-6, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cable separator spline of Ikeda to comprise the pockets to have a cross sectional area which is 75% or less than the cross sectional of a circular envelope of a cable or to have a cross sectional area which is about 25-75% the cross sectional of a circular envelope of a cable, since Ikeda teaches that the groove shape is not limited to the explained configuration and states that all types of variations in the design are included in the scope of the present invention and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller, 105 USPQ 233.*

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection. However, the examiner will address the arguments as they may be applied to the newly cited reference.

In response to applicant's argument that there is no suggestion to modify the reference to obtain the specified ranges or shape, the examiner recognizes that obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ikeda clearly teaches that the shape of the groove may be modified to comprise all types of variations. Specifically, on page 5, lines 8-14, under the heading "(Other variations)", Ikeda states

"Up to this point, a representative example as shown in Figure 1 with the shape, groove shape, number of grooves, and the like of the spacer (1) has been explained, but it is not limited to this, and equivalent results are obtained even if the cross section is square or polygonal for the spacer shape. That is to say, it goes without saying that all types of variations in the design are included within the scope of the present invention."

Based on this teaching, discovering the optimum or workable ranges would be obvious because certainly the modification could include the claimed configurations and ranges the applicant is claiming.

The Courts have been consistent that discovering optimum or variable ranges of a known device, doesn't constitute patentable subject matter. Specifically, the law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. See, e.g. *Garner V TEC Sys, Inc*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir.), cert. Denied, 469 US 830 [225 USPQ 232] (1984); *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980); *In re Ornitz*, 351 F.2d 1013, 147 USPQ 283 (CCPA 1965); *In re Aller*, 220 F. 2d 454, 105 USPQ 233 (CCPA 1955). These cases have consistently held that in such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range. *Gardner*, 725 F.2d at 1349, 220 USPQ at 786 (obviousness determination).

Therefore, the examiner respectfully submits that the 35 USC 103 rejection is proper and just.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Communication***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (703) 306-9061. The examiner can normally be reached on M-F 8:30 a. m. -6:00 p.m. (alternating Friday's off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (703) 308-3682. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3432 for regular communications and (703) 305-1341 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

*Dean A. Reichard 4/11/02*  
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